

DETAILED ACTION

Applicants' arguments, filed 1/4/2011, have been fully considered. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

Claims 1, 5, 6 and 21 stand rejected under 35 U.S.C. 103(a) as being unpatentable over US 2002/0119105 in view of US 4,748,198.

The rationale for obviousness of the invention as outlined in the previous 10/4/2010 Office action sufficiently renders obvious the current amended claims.

Regarding the "consisting essentially of" limitation, because the instant specification does not clearly indicate what the basic and novel characteristics actually are, "consisting essentially of" will be construed as equivalent to "comprising". See MPEP Sec 2111.03.

Applicants reiterate that neither reference discloses the effective ranges of shellac and rosin used together.

Applicants have further reiterated that In re Aller, 220 105 USPQ 233, 235 (CCPA 1955) is not applicable and states that the recited features are all critical in achieving the desired results, and this includes the drying time of less than 60 seconds. Applicants argue, for home use, the drying time of 60 seconds is critical. Applicants state this is so because 60 seconds is the limit for a person to keep his or her mouth open after having coated his or her teeth with a tooth coating agent. According to applicant, the 60 seconds limitation does not apply in the case of use by a professional, because it can take more than one minute to coat the teeth by a professional artist, and the customer will not complain because the artist can use a supporting tool to keep the mouth open. Applicant asserts it is important to distinguish between a professional use and a home use. Applicants state the present invention claims a composition suitable for home use.

The examiner does not find these arguments persuasive. Regarding the concentration ranges of for shellac and rosin together, the combination of references clearly suggests the claimed concentration ranges of for shellac and rosin together as the '105 publication discloses a specific amounts of shellac including 12% as outlined in the 10/4/2010 Office action and the ' 198 patent discloses the range of rosin of 0.5% to 29% and reasons to adjust the concentration, thereof (also outlined in the previous Office action).

Regarding applicants claims of criticality, the examiner notes that criticality is shown by objective evidence showing unexpected result. It is noted that there is no objective evidence showing unexpected results presented.

In response to applicant's argument that the current invention is for home use instead of professional use, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Applicant argues Takahashi teaches away from the present invention, if indeed the person of ordinary skill in the art were even to consider Takahashi, because Takashi teaches that rosin tends to lower the rate of volatilization of the organic solvent and thereby increasing drying time.

The examiner does not find this argument persuasive because, Takashi teaches that the drying time is increased when rosin is over a certain amount, this does not teach away from including rosin in the composition as outlined in the previous Office action. A reference will teach away when it suggests that the developments flowing from its disclosures are unlikely to produce the objective of the applicant's invention. In re Gurley, 27 F.3d 551, 553 (Fed. Cir. 1994). In the instant case, there is no teaching that the addition of rosin is unlikely or cannot produce the object of Applicant's invention, a tooth coating composition. In fact, the art teaches that the presence of rosin or rosin

derivatives provides for tooth adhesion (col. 3, lines 3-6). Therefore, the art does not discourage the solution but in contrast provides for a direct and necessary benefit of the presence of rosin in the composition. The art clearly recognizes a need for the balance of adhesion properties of the rosin and rate of volatilization of solvent from the rosin containing composition

Applicant argues one cannot learn about the effectiveness of rosin in a coating composition of shellac from anything taught by Takahashi wherein the resinous material is polystyrene rather than shellac.

The examiner does not find this persuasive because the rejection is based on the combination of references. One can learn about the effectiveness of rosin in a coating composition as Takashi is directed to coating compositions and describes the benefits provided by rosin in coating compositions.

No claims are allowed.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRIS SIMMONS whose telephone number is (571)272-9065. The examiner can normally be reached on Monday - Friday from 7:30 - 5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frederick Krass can be reached on (571) 272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/C. S./
Examiner, Art Unit 1612

/Patricia A Duffy/

Primary Examiner, Art Unit 1645